



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,910	06/09/1999	YUJIRO KAJIHARA	500.32049R00	7455

20457 7590 03/31/2003

ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON, VA 22209

EXAMINER

CLARK, JASMINE JHIHAN B

ART UNIT	PAPER NUMBER
----------	--------------

2815

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/328,910

Applicant(s)

KAJIHARA ET AL.

Examiner

Jasmine J B Clark

Art Unit

2815

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/9/02 & 1/9/02.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 and 50-72 is/are pending in the application.
- 4a) Of the above claim(s) 15-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 and 50-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14 & 17. 6) ☐ Other: _____

DETAILED ACTION

1. The indicated allowability of claims 1-36, and 50-72 is withdrawn because of the reasons below.

2. The supplemental amendment filed 01/04/02 in paper No. 17 is informal, because the change to column 1, lines 5-7 does not comply with 37 CFR 1.173(b).

Note that the text to be deleted is not enclosed in brackets and the text to be added is not underlined. See 37 CFR 1.173(d), and MPEP 1453.

For the above reason, Applicants are notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

3. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-36, and 50-72 are rejected as being based upon a defective reissue declaration filed 02/15/00 under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Art Unit: 2815

Note that the Reissue Declaration filed 02/15/00 does not cover the error being corrected by the claims 63-72 filed by the pre-amendment A dated 10/13/00. Please see MPEP 1414, item II, paragraph 1, and MPEP 1414.01 (Supplemental Reissue Oath/Declaration).

Claim Rejections – 35 USC § 251, Recapture

4. Claims 63-72 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The limitations, for example, “[w]herein the chip mounting portion is smaller than the semiconductor chip; suspension leads unitarily formed with the chip mounting portion by adhesive” were omitted in these independent claims of this new reissue application, whereas these limitations were previously claimed in the previous

Art Unit: 2815

application 09/311,021, which matured into US Patent No. 5,637,913. This omission provides a broadening aspect in the reissue claims, as compared to claims of the patents.

Remarks

5. A review of application No. 09/311,021, which matured into US Patent No. 5,637,913, reveals that, in response to the Office rejection of claims 25, 27-30, 43-46, 49, 51, and 52 of 05/14/96, Applicant argued that the combination proposed by the Office was not sufficient to render the claimed invention obvious/unpatentable. In Applicant's response of 09/16/96, it is repeatedly argued that an important feature of the invention is that the chip mounting portion is smaller in size than the semiconductor chip **(A)** (see page 8, first paragraph, and page 11, third and last paragraphs, for example). Also, repeatedly argued in response is the importance of the separate adhesive regions to mount the chip to the die and the suspension leads to the chip **(B)** (see page 8, first paragraph, and page 11, penultimate paragraph, through page 12, second paragraph, for example). These arguments were found persuasive by the Examiner and the claims were allowed. The Examiner's statement of reasons for allowance identified each of these aspects to support the allowance of the claims. Thus, the subject matter pertaining to these aspects of the invention has been surrendered during the original prosecution to obtain the patent currently being sought to reissue.

A review of the independent reissue claims indicates the aspects the invention relating to **A** and **B** have been omitted. As example above, these aspects of the

Art Unit: 2815

invention were surrendered to secure the original patent. Thus, the omission of these aspects from the reissue claims constitutes impermissible recapture of surrendered subject matter.

6. The references are cited and should be carefully considered: Ito (US 5,229,638), Masuda et al. (US 4,862,246), Yoshimoto et al. (US 5,293,064), Suzuki et al. (JP 2-229457), and Shibuya (JP 4-133453) show a structure of a semiconductor device comprising a lead frame including a plurality of suspension leads.

Telephone Inquiry Contacts

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine J. B. Clark whose telephone number is (703) 308-4857.

The examiner can normally be reached on From M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Lee can be reached on (703) 308-1690. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

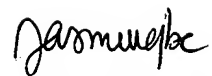
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 09/328,910

Art Unit: 2815

Page 6

jjbc/03/13/03



Jasmine J. B Clark
Primary Examiner
AU 2815